APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,684	09/28/2000	Neal Goldstein	PM 12607	7405

7590 06/02/2005	EXAMINER
Pillsbury winthrop llp Intellectual Property Group 11682 El Camino Real Suite 200 San Diego, CA 92130	BROWN, TIMOTHY M

ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>19 January 2005</u>.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21 and 23-44* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-21 and 23-44* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

This Non-Final Office action is responsive to the communication mailed January 19,

2005. Claims 1-21 and 23-44 are under examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

Claims 1-20 and 28-43 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Each of independent claims 1, 8 and 17 is indefinite for reciting "authoritative data

that is writable to . . . ." This language does not describe the nature of the claimed data with

particularlity such that one skilled in the art would understand the scope of the invention

being claimed. Moreover, the specification fails to provide an adequate description for the

meaning of "authoritative data that is writable to . . . ."

Independent claims 1, 8 and 17 are also indefinite for failing to indicate how the

claimed system limitations are connected to one another. For example, claim 1 recites a

plurality of customer facing utility systems . . . being adapted to communicate with customer

systems . . . ," yet claim 1 fails to indicate how the customer system and customer facing

utility system are connected to one another. The dependent claims also fail to indicate how

their limitations connect to the limitations of their corresponding independent claims. For

example, there is no indication of how, or if, the "firm side system" of claim 2 is connected to

the "plurality of customer facing utility systems" of claim 1.

Claim 20 is indefinite in that it lacks antecedent basis for the limitation "transaction

records in said authoritative data . . . ."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 and 23-44 are rejected under 35 U.S.C. 102(b) as being anticipated

by U.S. Pat. No. 4,980,826 to Wagner.

Claims 1-20 and 28-43 are interpreted as being drawn to an electronic commerce

system comprising a plurality of customer facing utility systems, a firm side system, and a

plurality of street side systems. The plurality of customer facing utility systems, the firm side

system, and the plurality of street side systems each have a set of associated data, as well

as a means for replicating the associated data between the different system types, as well

as between the individual systems.

It is worth noting that the following limitations do not carry patentable weight:

"said customer facing utility systems being adapted to communicate with customer

systems" (e.g. claim 1); and

"each of said street side systems being adapted to communicate with street systems" (e.g. claim 4).

These limitations do not carry patentable weight because they do not provide the claimed electronic commerce *system* with a physical limitation. Moreover, the claims do not positively recite a "customer system" or a "street system." Thus, adapting the claimed systems to communicate with these unrecited features cannot provide Applicant's invention with a physical feature that is worth consideration.

Based on this construction, Wagner anticipates claims 1-20 and 28-43 by disclosing a computerized exchange system comprising a plurality of remote terminals (col. 7, lines 42-46; and Fig. 1, chars. 18 and 20), a central processor (col. 7, lines 28-30; and Fig. 1), and a plurality of vendor systems (Fig. 15, char. 592).

Claims 21, 23-27 and 44 are drawn to a method for processing a transaction comprising entering a transaction request at one of a plurality of communication terminals, storing the transaction request in a data storage that is accessible by the plurality of communication terminals, sending the transaction request to a transaction-processing communication terminal, executing the transaction request, and storing a transaction execution record in a data storage that is accessible by the plurality of communication terminals. The claims provide that the transaction request may comprise a buy order, a sell order, an order cancellation, or a transaction inquiry.

Wagner anticipates claims 21, 23-27 and 44 by disclosing a method for performing transactions comprising:

receiving a transaction request at one of a plurality of terminals (col. 7, lines 41-47 and 61-64; and col. 12, lines 66-68);

recording the transaction request in a central storage accessible by the plurality of

workstations (col. 7, lines 55-57 and 61-64; col. 8, lines 50-53; col. 9, lines 1-4 and 46-49;

col. 14, lines 40-43; and col. 16, lines 40-49);

sending the transaction request to a transaction processing terminal (col. 6, lines 61-

64; col. 12, lines 65-67);

executing the transaction request (col. 7, lines 58-59 and 61-64); and

storing a record of the executed transaction in storage accessible to the plurality of

terminals (col. 7, lines 61-64; col. 8, lines 50-53; and col. 9, lines 1-4 and 46-49).

Wagner further discloses a buy order (col. 12, lines 5-6) a sell order (Id.), and an

order cancellation (col. 13, lines 29-30; and col. 15, line 50). Based on the foregoing,

Wagner anticipates the subject matter of claims 21, 23-27 and 44.

Claims 1-20 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated

by U.S. Pat. No. 4,799,156 to Shavit et al..

Claims 1-20 and 28-43 are interpreted as noted above. Shavit et al. disclose a

plurality of intelligent buyer terminals (i.e. customer facing systems), a plurality of intelligent

seller terminals (i.e. street side systems), and an interactive market management system

(i.e. firm system) (col. 5, lines 20-37; and Fig. 2). Shavit et al. further provide that each of

the listed components is coupled to a communication network and that the listed terminals

are capable of accessing a mass storage device (col. 5, lines 46-52). Based on the

foregoing, Shavit et al. anticipates the subject matter of claims 1-20 and 28-43.

Claims 1-21 and 26-43 are rejected under 35 U.S.C. 102(b) as being anticipated

by U.S. Pat. No. 5,270,922 to Higgins.

Claims 1-20 and 28-43 are interpreted as noted above. Higgins discloses a

hierarchy of data processing terminals comprising area, branch and workstation levels (col.

1, lines 39-45). Storage media at the different levels disseminate data over a

communication network (col. 1, lines 39-45). The data may be stored in a read only format

(col. 2, lines 18-25). Based on this disclosure, Higgins anticipates the subject matter of

claims 1-20 and 28-43.

Claims 21, 26 and 27 are drawn to a method for processing a transaction comprising

entering a transaction request at one of a plurality of communication terminals, storing the

transaction request in a data storage that is accessible to the plurality of communication

terminals, sending the transaction request to a transaction-processing communication .

terminal, executing the transaction request, and storing a transaction execution record in a

data storage that is accessible to the plurality of communication terminals. Higgins

anticipates this method in that it discloses a process for conducting a transaction comprising

receiving a request at one of a plurality of terminals (col. 1, lines 32-45; and col. 4, lines 21-

28), creating a record of the transaction request in storage that is accessible to the plurality

of terminals (col. 1, lines 32-45; col. 2, lines 26-41; col. 3, lines 58-65; col. 5, lines 47-55;

and col. 6, lines 64-67), sending the transaction request to a transaction-processing

terminal (col. 6, lines 46-67), executing the transaction request (col. 6, lines 46-67), and

storing a record of the execution of the transaction in a central storage that is accessible to

the plurality of terminals (col. 1, lines 32-45; col. 2, lines 26-41; col. 3, lines 58-65; col. 5,

lines 47-55; and col. 6, lines 64-67). Higgins further discloses responding to a transaction

inquiry based on transaction records in the central storage (col. 6, lines 30-32). Based on

the foregoing, Higgins anticipates the subject matter of claims 21, 26 and 27.

Claims 1-20 and 28-43 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,375,055 to Togher et al..

Claims 1-20 and 28-43 are interpreted as noted above. Togher et al. disclose an anonymous trading system comprising a first market access node, in communication with a first plurality of trader workstations (i.e. customer facing utility systems), a second market access node in communication with a second plurality of trader workstations (i.e. street side systems), and an arbitrator processing node (i.e. firm side system) in communication with said first and second market access nodes (Fig. 1; col. 5, lines 1-9, 15-19, 25-27, and 39-50; col. 11, lines 7-11; and col. 12, lines 31 et seq.). Based on the foregoing, Togher et al. anticipates the subject matter of claims 1-20 and 28-43.

Claims 1-21 and 23-44 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,269,343 B1 to Pallakoff.

Claims 1-20 and 28-43 are interpreted as noted above. Pallakoff anticipates the claims 1-20 and 28-43 by disclosing an online marketing system and method comprising:

a plurality of buyer client terminals with associated data (i.e. "customer facing utility systems") (Fig. 1, chars. 14a-14x; Fig. 9, chars. 96 and 97; col. 3, lines 22-27; and col. 4, lines 45-53);

a system controller with associated data (i.e. firm side system) (Fig. 1, char. 13b; and col. 3, lines 11-21); and

a plurality of seller client terminals with associated data (i.e. street side systems) (col. 3, lines 5-10).

Pallakoff also meets Applicant's variously recited "means for replicating data." This

follows because each of Pallakoff's components referenced above is coupled to a

communication network (see col. 2, lines 64-67).

Claims 21, 23-27 and 44 are interpreted as noted above. Pallokoff discloses, a

method of processing customer transactions comprising:

receiving a customer transaction request at one of a plurality of customer systems

(col. 4, lines 45-52; col. 7, lines 6-30);

creating a record of the transaction request and writing the record to data storage

associated with the one customer system (col. 7, lines 31-35);

replicating the transaction request record to data storage associated with the other

customer systems from the plurality of customer systems (col. 5, lines 3-6 and 33-37; col. 8,

lines 41-56; col. 8, lines 66-67);

sending the transaction request to one of a plurality of vendor systems (i.e. street

side systems) (col. 5, lines 38-40);

executing the transaction request at the vendor system (col. 5, lines 38-40);

creating a record of the executed transaction (col. 5, lines 38-40);

writing the record of the executed transaction to the one customer system (col. 8.

lines 50-53 and 66-67); and

replicating the transaction record to data storage associated with the other customer

systems (col. 8. lines 50-53 and 66-67). Pallakoff further discloses a transaction

comprising a sell order (col. 6, lines 38-39), and a transaction comprising a buy order (col.

4, lines 45-52; col. 7, lines 6-30). Based on the foregoing, Pallakoff anticipates the subject

matter of claims 21, 23-27 and 44.

Claims 1-20 and 28-43 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,021,470 to Frank et al..

Claims 1-20 and 28-43 are interpreted as noted above. Frank et al. disclose a data caching architecture comprising a central disc array (i.e. firm side system), a first plurality of workstations, and a second plurality of workstations, wherein the central disc array, first plurality of workstations, and second plurality of workstations are connected by a communication network (Fig. 1; col. 3, lines 41-61; and col. 4, lines 37-49). The first and second plurality of workstations are intelligent workstations having processing capabilities (col. 4, lines 36-49). Based on this disclosure, Frank et al. anticipates the subject matter of claims 1-20 and 28-43.

Claims 1-21 and 26-43 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,446,048 B1 to Wells et al..

Claims 1-20 and 28-43 are interpreted as noted above. Wells et al. disclose a Web-based system for financial transaction information comprising a plurality of intelligent client computers (i.e. customer facing utility systems) in communication with a server-enabled remote database (i.e. firm side system) and a plurality of request handlers (i.e. street side systems). Each of the plurality of intelligent client computers, the serve-enabled remote database, and the plurality of request handlers have an associated set of data and the ability to transmit the associated data between the components of the system (Figs. 1a and 1b; col. 6, lines 40-67; col. 7, lines 5-18 and 30-54; and col. 9, lines 10-15 and 24-30). Based on this disclosure, Wells et al. anticipates the subject matter of claims 1-20 and 28-43.

Claims 21, 26 and 27 are interpreted as noted above. Wells et al. disclose a method

for conducting a transaction comprising receiving a request at one of a plurality of terminals

(col. 9, lines 24-30; col. 10, lines 22-23; col. 14, lines 55-58; and col. 15, lines 11-15),

creating a record of the transaction request in a central storage that is accessible to the

plurality of terminals (col. 4, lines 27-31; col. 6, lines 40-44; and col. 7, lines 11-21, and 30-

34), sending the transaction request to a transaction-processing terminal (col. 9, lines 24-

34), executing the transaction request (col. 9, lines 24-34; and col. 15, lines 54-62), and

storing a record of the execution of the transaction in a central storage that is accessible to

the plurality of terminals (col. 4, lines 27-31; col. 6, lines 40-44; col. 7, lines 11-21, and 30-

34; and col. 15, lines 63-67). Wells et al. further disclose responding to a transaction inquiry

based on transaction records in the central storage (col. 15, lines 11-18). Based on the

foregoing, Wells et al. anticipate claims 21, 26 and 27.

Claims 1, 2, 8-10, 28-31 and 32-35 are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. Pat. No. 6,324,587 B1 to Trenbeath et al..

Claims 1, 2, 8-10, 28-31 and 32-35 are interpreted as being drawn to an electronic

commerce system comprising a plurality of customer facing utility systems and a firm side

system. The plurality of customer facing utility systems and the firm side system each

comprise a set of associated data, as well as a means for replicating the associated data

between the plurality of customer facing utility systems and the firm side system. The

plurality of customer facing utility systems further comprises a means for transmitting data

between each customer facing utility system within the plurality of customer facing systems.

Trenbeath et al..disclose a client-based system for sharing data objects comprising a

plurality of intelligent client computers (i.e. customer facing utility systems) that are in

communication with one another through at least one central server (i.e. firm side system) (Fig. 3A; col. 8, lines 17-24 and 54-61). Trenbeath et al. further provide that the plurality of intelligent client computers are configured to transmit data objects between one another to accomplish the replication of data among the plurality of intelligent client computers (see e.g. abstract, lines 14-18). Based on this disclosure, Trenbeath et al. anticipates the subject matter of claims 1, 2, 8-10, 28-31 and 32-35.

Response to Arguments

Applicants' argument regarding the art rejections are moot in view of the new grounds of rejection. However, Applicants' remarks merit a response in order for understanding the present claim rejections. The Examiner therefore responds as follows.

Applicants argue the references failed to teach or suggest a "customer facing utility system." The Examiner submits that the breadth of this limitation is sufficient to read upon any plurality of client devices that are capable of transmitting data to another device. This results because the claims simply recite a plurality of "customer facing utility systems" that are adapted to communicate with "customer systems." Moreover, the present system claims do not require a "customer system" since this limitation is not positively recited in the claims. Moreover, while claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Accordingly, Applicants' reference to the specification is unpersuasive.

Applicants further argue that characterizing the customer facing utility systems, and their associated data, as a centralized database is improper. Applicants point out that the

customer facing utility systems each have authoritative data and read only data. This

argument is not persuasive in that distinguishing the data configuration in this manner

places an emphasis on non-functional descriptive material (see MPEP section 2106,

subsection VI). Providing that the data is associated with each customer facing utility

system cannot provide a patentable distinction over a centralized database since both the

customer facing utility systems and a centralized database simply provide data access to a

plurality of systems.

It is also worth noting that the claims merely provide that the customer facing utility

systems are "associated" with authoritative data and read-only data. "Associating" data with

a system may be accomplished by connecting the system to a central data source. Thus,

the present claims do not require the authoritative data and read-only data to reside on

each customer facing utility system.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Timothy M. Brown whose telephone number is (571) 272-

0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Housel, can be reached on (571) 272-0902. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information

about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on

access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-

217-9197 (toll-free).

<div style="text-align: right;">

Timothy M. Brown
Examiner
Art Unit 1648

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tmb

HANI M. KAZIMI
PRIMARY EXAMINER